

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Office Action dated December 23, 2008. Reconsideration and allowance of the application in view of the remarks to follow are respectfully requested.

Claims 1-23 are pending in the Application. Claims 1, 9, 10 and 18 are independent claims.

In the Office Action, claims 1, 3, 4, 6-13, 15, 16 and 18-23 are maintained as rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,676,284 to Willson (Willson) in view of U.S. Patent Publication No. 2004/0179000 to Fermgard (Fermgard). Claims 5, 14 and 17 are maintained rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Willson in view of Fermgard in further view of U.S. Patent No. 6,801,276 to Epstein ("Epstein"). These rejections are respectfully traversed. It is respectfully submitted that claims 1-23 are allowable over Willson in view of Fermgard alone and in view of Epstein for at least the following reasons.

In a Response to Arguments section, the Final office Action takes a position that "the claimed libations in question are

functional and merely require the ability to perform the function."

This position is respectfully traversed. Claim 1 recites in pertinent part that (emphasis added) "the LED mounting and electric contacts to the connection wires are environmentally protected from exposure to the surroundings by a package of hot melt material." Claim 9 recites in pertinent part that (emphasis added) "the LED mounting and electric contacts to the connection wires are environmentally protected from the surroundings by a package of hot melt material, wherein the hot melt material of the assembly is configured to stop ingress of dust or splashed water in a quantity capable of interfering with operation of the assembly." The Office Action sets out a position that because the claims recite a function of the claims, it is sufficient that the prior art is capable of performing the function for the claims to be rejected. This position is respectfully traversed.

Further, claim 10 recites (emphasis added) "base is provided with electric connection wires wherein the LED mounting and electric contacts to the connection wires are environmentally protected from the surroundings by a package of hot melt material that surrounds exposed portions of the electric connection wires

and a portion of the LED." It apparently is also the position of the Final Office Action that this claim has no structure since the Final Office Action makes no attempt to discuss the deficiencies of this claim separately from that of claim 1. Clearly claim 10 provides structure which is not addressed by the Final Office Action.

Further, how can the Final Office Action take a position that in effect, simply because hot melt is capable of performing environmental protection, a teaching which heretofore has not been shown to be recognized by the prior art, that this possibility renders the present claims unpatentable.

The MPEP in § 2173.05(g) in addressing Functional Limitations acknowledges that (emphasis added) "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." The MPEP further acknowledges that "[a] functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v.*

Safari Water Filtration Sys. Inc., 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004)."

Yet the Final Office Action has failed to consider the present claims limitation and merely points to the prior art being capable of performing the recited element of environmental protection. Whether or not prior art is capable of performing the recitations of the claims is not a proper part of an obviousness analysis.

It is respectfully submitted that the present claim recitations convey to a person of ordinary skill in the art a feature which is not disclosed or suggested by the prior art. This point is apparently not disputed by the Final Office Action.

In the prior art, it is clear that environmental protection by the affixing with hot melt glue was not contemplated by the prior art in that while Fermgard shows affixing the LED with hot melt adhesive into a mounting hole (see, paragraph [0052]), it is clear that the hot melt adhesive of Fermgard does not protect the LED from exposure. In fact Fermgard teaches a (emphasis added) "protective sheet of glass 26 can be mounted over the outer end 13 of the mounting part 5 ... to protect the components arranged in

the mounting part 5." (See, Fermgard, FIG. 3 and paragraph [0053].)

While the Final Office Action tries to find support for the position for its position in "In re Hutchinson", it is respectfully submitted that this case is not on point since the claims do not recite "capable of providing environmental protection ...". Accordingly, the holding that the claim recitation does not constitute a limitation in any patentable sense is not relevant to the presently pending claims.

The prior case law has consistently acknowledged that there is nothing wrong with claiming a limitation functionally.

In re Schreider, 128 F3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) stated that "[a] patent applicant is free to recite features of an apparatus either structurally or functionally ...". It is axiomatic that a functional limitation should be accorded patentable weight. (See, e.g., *Ex parte Sherman*, 45, USPQ 532, 534 (Pat. Off. Bd. App. 1939):

While the claims contain numerous functional statements, these statements seem to be used for the purpose of clearly defining or differentiating elements which have been positively included in the claims. We see no objection to the use to the functional statement to define an element, even where the element may be set

forth by the term "means."

The MPEP in § 2173.01 Claim Terminology makes clear that (emphasis added) "Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought."

There is nothing wrong with describing a claim in functional terms as long as the terms are definite to a person of ordinary skill in the art. The present claims are definite and accordingly, there is nothing wrong with claiming the element functionally.

It is respectfully submitted that the simple act of fixing the LED with hot melt material does disclose or suggest that "the LED mounting and electric contacts to the connection wires are environmentally protected ..." as recited in the claims and whether or not the prior art is "capable" of performing this function is irrelevant to a proper obviousness analysis.

Since it is clear that Willson and Fermgard do not show this recitation of the claims, it is respectfully submitted that the assembly of claim 1 is not anticipated or made obvious by the teachings of Wilson in view of Fermgard. For example, Wilson in view of Fermgard does not disclose or suggest or inherently show for that matter, an assembly that amongst other patentable elements, comprises (illustrative emphasis added) "LED mounting and electric contacts to the connection wires are environmentally protected from exposure to the surroundings by a package of hot melt material" as recited in claim 1, and as similarly recited in each of claims 9, 10 and 18. Further, Wilson in view of Fermgard does not disclose or suggest or inherently show for that matter, an LED assembly that amongst other patentable elements, comprises (illustrative emphasis added) "base is provided with electric connection wires wherein the LED mounting and electric contacts to the connection wires are environmentally protected from the surroundings by a package of hot melt material that surrounds exposed portions of the electric connection wires and a portion of the LED" as recited in claim 10. Even in the improperly forwarded position of the Final Office Action, isn't this a structural

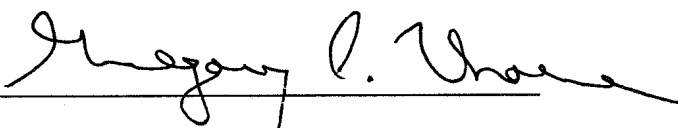
limitation which should be addressed and allowed in light of the shortcomings admitted in prior art. Since Epstein is introduced for allegedly showing elements of the dependent claims and as such, Epstein does nothing to cure the deficiencies in Wilson in view of Fermgard.

Accordingly, at least for these reasons, independent claims 1, 9, 10 and 18 are patentable over Wilson in view of Fermgard. Claims 2-8, 11-17 and 19-23 respectively depend from one of claims 1, 10 and 18 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
February 20, 2009

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101